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EXAMINER	
CHOUDHARY, ANITA	
ART UNIT	**PAPER NUMBER**
2153	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/605,544	COLE ET AL.	
	Examiner	Art Unit	
	Anita Choudhary	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 12-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-10 and 12-22 are pending.

Response to Arguments

In view of the Appeal Brief filed on June 29, 2004, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Applicant's arguments with respect to claims 1-10 and 12-22 have been considered but are moot in view of the new ground(s) of rejection. A new grounds or rejection has been made under 35 U.S.C. §103 using the Hughes (US 6,122,372) reference which was used to make 35 U.S.C. §102 rejection in the previous Final Office Action mailed on January 29, 2004. In briefly responding to Applicants concerns about the Hughes references, the Examiner offers the following clarifications.

Applicant argued in substance that no portion of Hughes shows "creating an object from a data file with a plug-in object corresponding to predetermined schema" as recited in claim 1 and similarly in claims 16 and 20. Applicant contends that Hughes method of "interpreting" is not the same as the claimed feature for "creating" an object. Furthermore, Hughes method for using template, protocol, and contract files does not teach or suggest the claimed plug-in object.

Applicant's attention is brought to column 9 lines 47-57, wherein a first message is received by a destination and a process for creating objects from the received message according to a template is demonstrated. In the cited section, a received message is interpreted to create payee, amount, and payor objects. A first data item received in the body of the received message is expected to be a payee, the second item is expected to be the amount, and the third item is expected to be the payor. This procedure creates objects by defining a payee, amount, and payor according to a predetermined template file (col. 9 lines 32-34). Without an appropriate template file the received data items would be meaningless, whereas with the template files the data items become defined objects corresponding to payee, amount, and payor. The receiving client uses the created objects (payee, amount, and payor) to conduct secure business transactions defining the parties involved in a specific sale. Given this feature, it is evidenced that although Hughes does not use the terminology "creating" an object, Hughes disclosure clearly suggests the concept of creating objects for a payee, amount, and payor.

Appellant further argues that Hughes does not show the plug-in feature of claim 1. Again, it is recognized that terminology identical to the claims is not required to show anticipation. A plug-in object is simply a small software application used to add features to a larger system and as defined by Appellant's specification, "...an appropriate plug-in parses and

extracts data from a data file..." (page 11 line 20-21). On the same accord, Hughes underlying concept is to use an appropriate software protocol to interpret and create objects (as shown above) from messages sent across a network of dissimilar terminals (col. 5 lines 53-67). In other words, each message is interpreted using software protocols that exist on the receiving computer and in order to ensure that an interpretation created from a message sent across a diverse network is correct, each message encapsulates information that specifies how the party expects the message to be parsed, accepted, interpreted, and acknowledged (col. 5 line 64-col. 6 line 5). Information for creating a correct interpretation may include template, protocol, and contract ID's that directly corresponds to template, protocol, and contract files held at the receiving client (col. 8 lines 26-34, note especially that data files can determine how the message should be handled and acted upon). Messages are processed at the receiving client according to a specified software protocol, template, and contract (col. 10 lines 11-29). For example, a protocol ID in a received message facilitates a software protocol application to run at the receiving client in order to handle the message in a certain way (col. 9 lines 58-63). Therefore, although Hughes does not use the terminology "plug-in object", Hughes does suggest the concept of a software protocol and software templates (plug-in objects) being used to create objects like payee, amount and payee.

The Hughes reference has nonetheless been modified to present new grounds of rejection. However, Applicant should take the above clarification of the Hughes reference into consideration.

In briefly responding to Applicants concerns about the Lection references, the Examiner offers the following clarifications.

Applicant argues that Lection does not teach the limitation of claim 12 stating: "data field containing data file formatted in a markup language in accordance with the schema; and data field containing manifest information corresponding to information contained in the data file data field." In reply, the data field containing data file formatted in a markup language in accordance to XML schema can be shown in figures 13A- 13E, wherein the data file is expressed in XML format as XML datastream for host (col. 10 lines 14-28). Data field containing manifest information corresponding to the information contained in the data file data field is expressed in figures 10A-10E (col. 9 lines 4-27). As seen in figures 10A-10E, the data type definitions or DTD (manifest data) are defined within tags that are hydrated by the XML datastream in order to be displayed on host screen. Therefore, Lection shows both a data field for markup language and data field for manifest information (DTD).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,446,110 to Lection et al. (hereinafter "Lection").

In considering claim 12, Lection discloses a computer-readable medium having stored thereon a data structure comprising:

a data field containing address information (see column 9, line 19 ("host port number"));

a data field containing the identification of a predetermined schema (see column 9, lines 4-6);

a data field containing a data file formatted with a markup language in accordance with the schema (figures 13A-13E, col. 10 lines 14-19); and

a data field containing manifest information corresponding to the information contained in the data file data field (see figure 10A-10E, column 9, lines 7-9 and 22-30).

In considering claim 13, Lection et al. further discloses a data field containing state information (see column 9, lines 16-18).

In considering claim 14, Lection et al. further discloses wherein the state information contains address information (see column 9, line 19 ("host port number")).

In considering claim 15, Lection et al. further discloses wherein the address information contains an address for replying to a message (see Fig. 4; Note that the double arrows show that the datastreams are going in both directions between the source and destination and therefore the address information must contain an address for replying to the datastream message in order for it to be transmitted back to the host.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 6-10, 16, 17, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 6,122,372) in view of Hayward et al. (US 6,279,043).

In considering claim 1, Hughes discloses a method for exchanging data between a source location and a destination location (column 5, lines 39-41) comprising:

generating a data file with a markup language in accordance with a predetermined schema (column 8, lines 35-39);

generating a first software envelope containing the data file (column 6, lines 6-14);

transmitting the data file software envelope to the destination location (column 5, lines 64-67 – column 6, lines 1-5); and

creating an object from the data file with a plug-in object corresponding to the predetermined schema (column 9, lines 25-32).

Although Hughes shows substantial feature (if not all) of the claimed features, Hughes may not explicitly teach "creating" an object and "plug-in object" of the claimed invention. Nonetheless this feature is well known in the art, and would have been an extremely obvious modification to the system disclosed by Hughes, as evidenced by Hayward.

In an analogous art Hayward shows a method for manipulating a file having a format identifying whether a compatible format for the file is known by an API and executing a script on the file when a compatible format is known (col. 1 lines 55-63). Hayward shows the creation of objects (e.g. graphics, text) using application plug-ins (col. 2 lines 35-40). In one instance a language translation plug-in is used to create translated text (col. 4 lines 14-18, see also figure 3 52, 56).

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Hughes to employ the feature shown by Hayward in order to efficiently use program resources at an end-user (see Hayward col. 1 lines 49-53).

In considering claim 6, 19, and 22, Hughes further discloses wherein the markup language comprises standard generalized markup language (SGML) (column 8, lines 35-39).

In considering claim 7, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via electronic mail (column 8, lines 43-44).

In considering claim 8, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via HTTP (column 8, lines 43-45; Note that it is inherent that HTML is sent via HTTP).

In considering claim 9, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via an intermediate server (column 5, lines 48-52).

In considering claim 10, Hughes further discloses a computer-readable medium having computer-executable instructions for performing the steps recited in claim 1 (Note that it is inherent that in order to perform the method steps there must be a computer-readable medium with computer-executable instructions.).

In considering claim 16, Hughes discloses a method for creating data at a source location to transmit to a destination location (column 5, lines 39-41), comprising the steps of:

generating a data file with a markup language in accordance with a predetermined schema (column 8, lines 35-39);

generating a software envelope containing the data file (column 6, lines 6-14);

identifying a plug-in object that creates an object from the data file (column 9, lines 25-32); and

transmitting the software envelope to the destination location (column 5, lines 64-67 – column 6, lines 1-5).

Although Hughes shows substantial feature (if not all) of the claimed features, Hughes may not explicitly teach "creating" an object and "plug-in object" of the claimed invention. Nonetheless this feature is well known in the art, and would have been an extremely obvious modification to the system disclosed by Hughes, as evidenced by Hayward.

In an analogous art Hayward shows a method for manipulating a file having a format identifying whether a compatible format for the file is known by an API and executing a script on the file when a compatible format is known (col. 1 lines 55-63). Hayward shows the creation of objects (e.g. graphics, text) using application plug-ins (col. 2 lines 35-40). In one instance a language translation plug-in is used to create translated text (col. 4 lines 14-18, see also figure 3 52, 56).

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Hughes to employ the feature shown by Hayward in order to efficiently use program resources at an end-user (see Hayward col. 1 lines 49-53).

In considering claim 17, Hughes further discloses wherein generating a software envelope containing the data file (column 6, lines 6-14) and the plug-in object (column 9, lines 25-32).

In considering claim 20, Hughes discloses a method for extracting data from a file transmitted from a source location, comprising the steps of:

receiving a software envelope containing a data file marked up with a markup language in accordance with a predetermined schema (column 5, lines 64-67 – column 6, lines 1-5); and

creating an object from the data file with a plug-in object corresponding to the predetermined schema (column 9, lines 25-32).

Although Hughes shows substantial feature (if not all) of the claimed features, Hughes may not explicitly teach "creating" an object and "plug-in object" of the claimed invention. Nonetheless this feature is well known in the art, and would have been an extremely obvious modification to the system disclosed by Hughes, as evidenced by Hayward.

In an analogous art Hayward shows a method for manipulating a file having a format identifying whether a compatible format for the file is known by an API and executing a script on the file when a compatible format is known (col. 1 lines 55-63). Hayward shows the creation of objects (e.g. graphics, text) using application plug-ins (col. 2 lines 35-40). In one instance a language translation plug-in is used to create translated text (col. 4 lines 14-18, see also figure 3 52, 56).

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Hughes to employ the feature shown by Hayward in order to efficiently use program resources at an end-user (see Hayward col. 1 lines 49-53).

Claims 5, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes and Hayward in view of Lection.

In considering claims 5, 18 and 21 Hughes and Hayward fail to disclose *wherein the markup language comprises extensible markup language (XML)*. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes and Hayward, as evidenced by Lection. Lection discloses that the markup language of the data file comprises extensible markup language (column 6, lines 34-35). A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system disclosed by Hughes and Hayward by incorporating this well known feature, such as disclosed by Lection, in order to allow for greater flexibility in organizing and presenting information in the data file.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes and Hayward in view of Chen et al. (US 6,507,856).

In considering claim 2, Hughes and Hayward fail to disclose *automatically generating a second software envelope from the information contained in the first software envelope.* Nonetheless, this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes and Hayward, as evidenced by Chen. In an analogous art Chen discloses a system for exchanging messages over a network including automatically generating a second software envelope from the information contained in the first software envelope (column 3, lines 50-60). A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system disclosed by Hughes and

Hayward by incorporating this well known feature, such as disclosed by Chen, in order to allow for greater efficiency when transferring a document back to the original destination.

In considering claim 3, Hughes further discloses wherein the first software envelope contains destination and source address information (Fig. 2, "210" and "214") however it fails to disclose *generating a second envelope having a destination address matching the source address of the first envelope.* Nonetheless, this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes and Hayward, as evidenced by Chen. In an analogous art Chen discloses a system for exchanging messages over a network including generating a second envelope having a destination address matching the source address of the first envelope (column 3, lines 50-60). A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system disclosed by Hughes and Hayward by incorporating this well known feature, such as disclosed by Chen for the reasons cited above with respect to claim 2.

In considering claim 4, Hughes further discloses wherein the first software envelope contains state information (Fig. 2) however it fails to disclose *generating a second envelope having a destination address determined by the state information.* Nonetheless, this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes and Hayward, as evidenced by Chen. In an analogous art Chen discloses a system for exchanging messages over a network including generating a second software envelope having a destination address determined by the state information (column 3, lines 50-60). A person having ordinary skill in the art would have readily recognized the desirability and advantages of

modifying the system disclosed by Hughes and Hayward by incorporating this well known feature, such as disclosed by Chen, for the reasons cited above with respect to claim 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita Choudhary whose telephone number is (703) 305-5268. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FRANTZ B. JEAN
PRIMARY EXAMINER

Anita Choudhary
October 1, 2004